

REMARKS/ARGUMENTS

Status of the Claims

After entry of this amendment, claims 1-18 and 21-23, 28 and 29 are pending.
Applicants thank the Examiner for allowing claims 8, 9, 12-18 and 21-23.

Amendments to the Claims

Claims 1, 2 and 5 have been amended for clarity and to cancel subject matter without prejudice.

Claim 10 has been amended for clarity and to correct for grammar.

Claims 12 and 13 have been amended for clarity.

Allowed claim 16 has been amended for clarity and to include a limitation recited in allowed claim 12, from which it depends. Since claim 16 as amended continues to present a choice of species of the Markush group recited in allowed claim 12, it is submitted that claim 16 as amended is also allowable.

Claims 28 and 29 are new and depend from claim 1. Support for the claims can be found in claim 1 as filed in the preliminary amendment of August 25, 2003.

No new matter has been added by these amendments. Entry of the amendments is therefore respectfully requested.

Responses to the Rejections

Under 35 U.S.C. § 102(b)

Claims 1, 5 and 6 are rejected under 35 USC § 102(b) as allegedly being anticipated by Morgan et al., WO/1996/017626 (Applicants believe that the Examiner intended to cite this reference instead of "WO 96/176626"). The Examiner alleges that Morgan teaches the solubilizing agent polyoxyethanyl-cholesteryl sebacate (PCS).

In order to expedite prosecution, the term "polyoxyethanyl-cholesteryl sebacate" has been deleted from claims 1 and 5. Morgan does not anticipate the claims as amended. Withdrawal of the rejection is therefore respectfully requested.

Under 35 U.S.C. § 103(a)

Claims 7, 10 and 11 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Morgan in view of Goldman, WO/1998/003170. Claims 2-4 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Morgan in view of Crooks, US Patent 4,572,915. The Examiner alleges that Morgan teaches the solubilizing agent PCS and that Goldman and Crooks teach additional features so as to render the rejected claims obvious.

In order to expedite prosecution, the term “polyoxyethanyl-cholesteryl sebacate” has been deleted from claim 2 and claim 5. Since claims 3 and 4 depend from claim 2 and since claims 7, 10 and 11 depend from claim 5, the cited references in combination do not teach all of the limitations of the rejected claims. As such, there is no reason of record why the combination of references suggests the claims as amended, and hence, a *prima facie* case of obviousness for claims 2-4, 7, 10 and 11 has not been established. Withdrawal of the rejection is therefore respectfully requested.

Double Patenting

Claims 1-18 and 21-23 are provisionally rejected on the ground of obviousness-type double patenting over claims 21-43 of copending US Application No. 11/888,332 and claims 1-89 of copending US Application No. 12/024,936.

Claims 21-43 of US Application No. 11/888,332

Applicants respectfully request that the Examiner hold in abeyance the rejection of claims 1-18 and 21-23 while rejection of the claims on other grounds is pending. If the Examiner withdraws the rejection of the claims under 35 U.S.C. §§ 102(b) & 103(a) discussed above, Applicants respectfully request that the double patenting rejection of the present pending claims over the claims of US Application No. 11/888,332 be withdrawn and that the Examiner allow the present claims to proceed to issue according to MPEP 804(I)(B)(1), which provides that if a provisional nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Claims 1-89 of US Application No. 12/024,936

The present claims are directed to, for example, compositions comprising a solubilizing agent and either a compound having a high content of polyunsaturated fatty acids or a bioactive lipophilic compound selected from a terpene or a terpenoid (claim 1); compositions comprising a solubilizing agent and either a tocotrienol or CoQ₁₀ in certain ratios (claim 12); compositions comprising PTS and alpha-tocopheryl acetate in a certain ratio (claim 21); and methods of making these compositions.

If the Examiner withdraws the rejection of the claims under 35 U.S.C. §§ 102(b) & 103(a) as discussed above, Applicants respectfully request that the double patenting rejection of the present pending claims over the claims of US Application No. 12/024,936 be withdrawn and that the Examiner allow the claims to proceed to issue according to MPEP 804(I)(B)(1), for the same reasons discussed above.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1000. The Commissioner is authorized to charge any additional fees that may be required or to credit any overpayment to Deposit Account No. 50-0310 (Docket No. 061810-5019-US03).

Respectfully submitted,
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